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10/734,465	12/12/2003	Larry Lee MacKeben		9592

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EXAMINER

COOLMAN, VAUGHN

ART UNIT PAPER NUMBER

3618

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,465

Applicant(s)

MACKEBEN, LARRY LEE

Examiner

Vaughn T. Coolman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 02252006.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. Examiner respectfully suggests that priority should be claimed to application 60/432,955 as discussed in a telephone interview with the applicant on 02/24/2006.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an

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unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the citizenship of each inventor.

Examiner respectfully suggests filing a new oath/declaration specifying the country of citizenship of each inventor.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “the contoured surface following the contour of a motorcycle fender” positively recited in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because there are no reference numbers, the line quality is poor, numbers and reference characters are not oriented in the same direction as the view or plain and legible, the photographs are of poor quality, the views are not labeled separately or properly, and the views are not numbered. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. Examiner respectfully suggests the applicant may also perform his own drafting if the rules of 37 CFR 1.84 are followed in regards to the infractions listed above. The above list is not necessarily exhaustive and 37 CFR 1.84 should be consulted by the applicant as to the proper standards for drawings submitted to the Office.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: The specification is replete with grammatical errors, for example:

- A. Paragraph 0001, line 2 – the phrase “a motorcycle utility platforms” is unclear the word “a” indicates singular subject, the word “platforms” is obviously plural.
- B. Paragraph 0002, line 2 – the word “appropriately” is misspelled.
- C. Paragraph 0004, line 4 – the sentence “Which causes marring of the rear fender.” is a sentence fragment.

The above list is not exhaustive, only representative of the specification as a whole.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities: the word “couplable” is misspelled in line 3 of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The identification of the frame component or portion of the frame which the platform is to be coupled to is critical or essential to the practice of the invention, but not included in the claim(s) and is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Examiner respectfully suggests that examples of frame components on which the platform could be mounted be described in the specification. No new matter should be entered. Only subject matter that was disclosed in the provisional application filed by the applicant can be referenced, and only after a proper priority claim according to 37 CFR 1.78(a) is made.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the structure, other than being attached to the frame of something, allowing the bracket to avoid contact with the fender finish.

Examiner respectfully suggests that claim 2 should depend from claim 1 and possibly be rewritten into multiple dependent claims regarding the subject matter set forth in line one of claim 2.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Grove (U.S.

Patent No. 6,648,408 B1).

[**claim 1**] Grove discloses (see FIGS 1-6) a platform (42) for a motorcycle, the platform including at least two brackets (18 and 20), each bracket including at least two mounts (24), one of the mounts being couplable to a frame component (14) of the motorcycle; a contoured surface (46) attached to each bracket (18, 20) via at least two arms (48 and 62), the contoured surface following the contour of a motorcycle fender (22) and forming a gap (shown in FIG 1) between the motorcycle fender (22) and the contoured surface (46), the gap inherently protecting the surface of the motorcycle fender.

Claim 4 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fuller (U.S. Patent No. 4,993,731).

[**claim 3**] Fuller discloses (see FIGS 1 and 2) a bracket (1' or 1'') for coupling a sissy bar (3), the bracket having a v-shaped configuration when viewed from the side. Examiner notes that "v-shaped configuration" is being read reasonably broad as a triangular shaped configuration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grove.

[claim 2] Grove further discloses that the present invention is not limited to the precise arrangement shown in the drawings. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the platform shown by Grove by changing size of the platform for a different model of motorcycle since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to modify the platform shown by Grove use different materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the platform shown by Grove by altering the shape and design for a different model of motorcycle. One of ordinary skill in the art could easily recognize that shape and design should follow the design intent of the original manufacturer in order to disguise the structure used for mounting as disclosed by Grove (Column 1, lines 54-63). Furthermore, Grove discloses a load bearing bracket (18 or 20) attached to the frame (14) following the fender (22) contour without making contact with the fender finish. Grove accomplishes this without bracing to the rear axle (not shown).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuller.

[claim 3] Fuller discloses a bracket (1' or 1'') for coupling a seat back (4) hereto, the bracket having a v-shaped configuration. Examiner notes that "v-shaped configuration" is being

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read reasonably broad as a triangular shaped configuration. Fuller does not teach an “armrest seat back” being attached to the bracket. However, armrests for attachment to conventional back rests or sissy bars have been commercially available since before the time that the invention was made. Please see attached form PTO-892 and the related documents for evidence of the commercial availability of such armrests. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the seat back shown by Fuller with a commercially available armrest since such a modification would provide additional comfort for the passenger of the vehicle.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shephard (U.S. Patent No. 2,491,062), Hoose (U.S. Patent No. 1,382,942), and Kramer (U.S. Patent No. 4,163,513) teach a motorcycle utility platform including features of the claimed invention.

Bowen (U.S. Patent No. 3,913,974) teaches a v-shaped bracket for a motorcycle.

Hanagan et al (U.S. Patent No. 4,225,183) teaches an armrest for a seatback of a motorcycle.

Lovett (U.S. Patent Application Publication No. US 2003/0201292 A1), Kuelbs et al (U.S. Patent No. 5,779,303), and Abram (U.S. Patent No. 4,030,750) teach a v-shaped bracket for coupling a sissy bar to a motorcycle.


Lake Jr. (U.S. Patent No. 1,565,016) teaches a motorcycle platform including features of the claimed invention.

Reichert (U.S. Patent No. 5,558,260) teaches a motorcycle utility platform including features of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vaughn T. Coolman whose telephone number is (571) 272-6014. The examiner can normally be reached on Monday thru Friday, 8am-6pm EST.

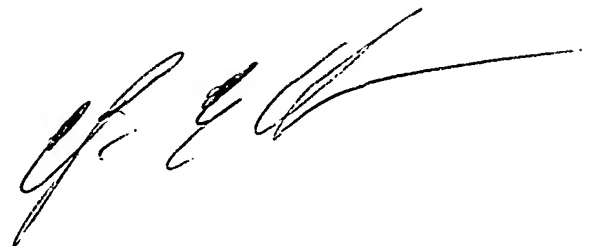
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


03/03/06

vtc

Travis Coolman
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